

REMARKS

Reconsideration is respectfully requested in view of any changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment.

At page 14 the Office Action states:

Claims 438-440 and 453 are rejected over applicants admitted prior art. Specifically, these claims do not require the presence of any superconductive compound or composition. They recited only "means for conducting a superconducting current...". The examiner construes these limitations to read on any device(s) which test for superconductivity. Applicant admits such were known prior to the filing of the instant specification (response filed 1/31/05, page 176).

On November 11, applicants' attorney discussed this matter with the Examiner by telephone. To clarify this matter claim 438 and 439 are amended. Claim 438 has been amended to modify "comprising a T_c greater than or equal to 26°K" to "at a temperature greater than or equal to 26°K". Claim 438 has been amended to add "a means for providing an electric current to flow in said means for conducting a superconducting current at said temperature." This added language is similar to the language in the last clause of claims 409-413 and other claims.

Claim 439 has been amended to be consistent with the modification to claim 438 from which it depends to change, "at a temperature greater than or equal to 26°K" to "comprises a T_c greater than or equal to 26°K".

Claim 440 has been amended to be consistent with the modification of claim 438 from which it depends, to change “at a temperature less than said T_c ” to “at said temperature.”

Claim 438 is in means plus function form as expressly permitted by 35 USC 112 paragraph 6.

Claim 438-440 as amended are clearly not directed to a device which tests for superconductivity. Applicants are the first persons to discover a “means for conducting a superconducting current at a temperature greater than or equal to 26°K.” For this discovery they received the Nobel Prize in Physics in 1987. Applicants have used in claims 438-465 a claim structure expressly authorized by 35 USC 112 paragraph 6. Since the Examiner has allowed claims in this application those claims should be allowable.

In view of the changes to the claims and the remarks herein, the Examiner is respectfully requested to reconsider the above-identified application. If the Examiner wishes to discuss the application further, or if additional information would be required, the undersigned will cooperate fully to assist in the prosecution of this application.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

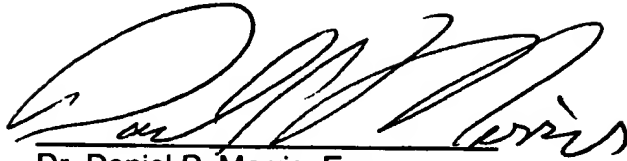
If the above-identified Examiner's Action is a final Action, and if the above-identified application will be abandoned without further action by Applicants, Applicants file a Notice of Appeal to the Board of Appeals and Interferences appealing the final rejection of the claims in the above-identified Examiner's Action. Please charge deposit account 09-0468 any fee necessary to enter such Notice of Appeal.

In the event that this amendment does not result in allowance of all such claims, the undersigned attorney respectfully requests a telephone interview at the Examiner's earliest convenience.

MPEP 713.01 states in part as follows:

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, ... the examiner, as soon as he or she has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Dr. Daniel P. Morris", written over a horizontal line.

Dr. Daniel P. Morris, Esq.
Reg. No. 32,053
(914) 945-3217

IBM CORPORATION
Intellectual Property Law Dept.
P.O. Box 218
Yorktown Heights, New York 10598